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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,531	03/01/2004	Daniel L. Carter	2002-0852.01/4670-270	2754

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LEXMARK INTERNATIONAL, INC.  
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EXAMINER	
MORRISON, THOMAS A	

ART UNIT	PAPER NUMBER
3653	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/09/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/790,531

Applicant(s)

CARTER ET AL.

Examiner

Thomas A. Morrison

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 and 20-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13-18 and 20-30 is/are allowed.
- 6) ☒ Claim(s) 1-4, 9, 10 and 12 is/are rejected.
- 7) ☒ Claim(s) 5-8 and 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The indicated allowability of claims 1-4, 9-10 and 12 is withdrawn in view of the newly discovered reference(s) to U.S. Patent No. 5,093,690 (Ohno et al.). Rejections based on the newly cited reference(s) follow. The examiner regrets any inconvenience that may have been caused by this new Office Action.

#### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a) because they fail to show (1) the recited frictional clutch of claim 17 as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and

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informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. Figure 9 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### ***Specification***

4. The disclosure is objected to because of the following informalities: (1) the recited frictional clutch of claim 17 should be given a reference numeral in the specification, since this is a claimed element.

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-4, 9-10 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,093,690 (Ohno et al.)(cited in the 6/29/2004 IDS).

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Regarding claim 1, Figs. 1 and 18A-18D show a device to move media sheets simultaneously within an image forming device comprising:

a first media nip formed by a drive roll (including 22 and/or 28) and a first roll (unnumbered roll above 22 in Fig. 1) that is positioned against the drive roll (including 22 and 28);

a second media nip formed by the drive roll (including 22 and/or 28) and a second roll (23) that is positioned against the drive roll (including 22 and 28);

a diverter (including 29) operatively connected to the drive roll (including 22 and/or 28) and controlled to move to a first position (Fig. 18A) when the drive roll (including 22 and/or 28) rotates in a first direction to align a first guide edge (contact edge of 29 in Fig. 18A) of the diverter (including 29) to guide a first media sheet into the first media nip, the diverter controlled to move to a second position (Fig. 18C) when the drive roll (including 22 and/or 28) rotates in a second direction to align a second guide edge (contact edge of 29 in Fig. 18C) of the diverter (including 29) to guide the first media sheet out of the first media nip, and align the first guide edge of the diverter to simultaneously guide a second media sheet into the second media nip. See also column 7, line 41 to column 8, line 30.

Regarding the recitation "to align a first guide edge of the diverter to guide a first media sheet into the first media nip", this recitation has **not** been given patentable weight in view of MPEP, section 2114. Similarly, the recitation "to align a second guide edge of the diverter to guide the first media sheet out of the first media nip, and align the

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first guide edge of the diverter to simultaneously guide a second media sheet into the second media nip" has also **not** been given patentable weight in view of MPEP, section 2114. Specifically, MPEP, section 2114 states that, "While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function." See MPEP, section 2114. As such, it is the examiner's position that all of the features of claim 1 are disclosed in U.S. Patent No. 5,093,690 (Ohno et al.).

Regarding claim 2, Figs. 1 and 18A-18D show that the drive roll (including 22 and/or 28) is mounted to a drive shaft (27), and the first roll (unnumbered roll above 22 in Fig. 1) and the second roll (23) are each mounted to a housing of the image forming device.

Regarding claim 3, column 7, lines 57-63 disclose a motor attached to the drive roll (including 22 and/or 28) to rotate the drive roll in the first direction and the second direction.

Regarding claim 4, Figs. 1 and 18A-18D show that the first nip is formed on an upper edge of the drive roll (including 22 and/or 28), and the second nip is formed on a lower edge of the drive roll (including 22 and/or 28).

Regarding claim 9, Figs. 18A-18D show that the diverter (including 29) is positioned at an intersection of a first media path and a second media path.

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Regarding claim 10, Figs. 1 and 18A-18D show a device to move media sheets simultaneously within an image forming apparatus comprising:

a drive roll (including 22 and/or 28) positioned against a first roll (unnumbered roll above 22 in Fig. 1) to form a first nip and positioned against a second roll (23) to form a second nip;

a diverter (including 29) operatively connected to the drive roll (including 22 and/or 28) and having a first guide edge (contact edge of 29 in Fig. 18A) and a second guide edge (contact edge of 29 in Fig. 18C), the diverter (including 29) positionable between a first orientation (Fig. 18A) and a second orientation (Fig. 18C); the diverter (including 29) positioned in the first orientation (Fig. 18A) when the drive roll (including 22 and/or 28) rotates in a first rotational direction to guide along the first guide edge a first media sheet that is driven by the first nip in a first direction; the diverter positioned in the second orientation (Fig. 18C) when the drive roll (including 22 and/or 28) rotates in a second rotational direction to guide along the second guide edge the first media sheet that is driven by the first nip in a second direction, and simultaneously guide a second media sheet along the first guide edge that is being driven by the second nip in the first direction. See also column 7, line 41 to column 8, line 30.

Regarding the recitation "to guide along the first guide edge a first media sheet that is driven by the first nip in a first direction", this recitation has **not** been given patentable weight in view of MPEP, section 2114. Similarly, the recitation "to guide along the second guide edge the first media sheet that is driven by the first nip in a

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second direction, and simultaneously guide a second media sheet along the first guide edge that is being driven by the second nip in the first direction” has also **not** been given patentable weight in view of MPEP, section 2114. Specifically, MPEP, section 2114 states that, “While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function.” See MPEP, section 2114. As such, it is the examiner’s position that all of the features of claim 10 are disclosed in U.S. Patent No. 5,093,690 (Ohno et al.).

Regarding claim 12, Figs. 1 and 18A-18D show that the first roll (unnumbered roll above 22 in Fig. 1) and second roll (23) are positioned in contact with the drive roll (including 22 and/or 28) and rotation of the drive roll rotates both the first roll and the second roll.

### ***Allowable Subject Matter***

6. Claims 13-18 and 20-30 are allowed. Claims 5-8 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Morrison whose telephone number is (571) 272-7221. The examiner can normally be reached on M-F, 8am - 5pm.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on (571) 272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

04/01/2007



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